



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of  
Anthony G. Picardo  
Serial No. 09/574,688

Atty. Docket  
PH US000423  
Examiner: M. Bockelman

Filed: May 17, 2000

GAU: 3762

Title: SMART MEDICAL CONNECTOR SYSTEM AND METHOD OF USE

Commissioner for Patents  
PO Box 1450  
Alexandria, VA 22313

**RECEIVED**

FEB 09 2004

**PETITION UNDER 37 CFR 1.181 TO  
WITHDRAW NOTICE OF ABANDONMENT**

TECHNOLOGY CENTER R3700

Sir:

Applicant respectfully requests the Commissioner for Patents to restore the subject application to pending status on the ground that Applicant did respond in a timely manner to the Office Letter mailed by the Patent Office in this case on June 26, 2003. Applicant filed a Response to Office Action in this case on July 15, 2003, transmitted by facsimile, in timely response to the Office Action dated June 26, 2003.

Attached as Exhibit 1 is a copy of the Notice Of Abandonment dated January 7, 2004.

Attached as Exhibit 2 is the Response to Office Action with the Certificate of Mailing or Transmission on the first page of the Response signed by Elissa DeLuccy on July 15, 2003, with the box beside the facsimile transmission statement clearly marked.

Attached as Exhibit 3 is a copy of the Auto-Reply Facsimile Transmission from the Patent Office showing the first page of the Response to Office Action. The Auto-Reply page date stamp evidences that the PTO received the Response on July 15, 2003, at 3:07:09 PM EDT, and that the transmission consisted of 3 pages.

FEE

The Commissioner is hereby authorized to charge Deposit Account No. 14-1270 for any petition fee, which may be due. However, since it is believed that the holding of abandonment is the result of circumstances not attributable to any fault by Applicant or his representative, it is respectfully suggested that no fee is due.

Applicant's undersigned attorney may be reached by telephone at (425) 487-7152. All correspondence should continue to be directed to our below listed address.

Respectfully submitted,

By W. Brinton Yorks, Jr.  
W. Brinton Yorks, Jr., Reg. 28,923  
Philips Electronics  
22100 Bothell Everett Highway  
Bothell, WA 98021  
(425) 487-7152

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited this date with the United States Postal Service as first-class mail in an envelope addressed to:

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Alexandria, VA 22313

On 30 January 2004  
(Mailing Date)

By Jill Priestrup  
(Signature)



UNITED STATES PATENT AND TRADEMARK OFFICE

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US000423

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/574,688	05/17/2000	Anthony G. Picardo	10001826.1	8758

24737 7590 01/07/2004

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EXAMINER
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BOCKELMAN, MARK

ART UNIT	PAPER NUMBER
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3762

DATE MAILED: 01/07/2004

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JAN 15 2004

J. PEISTRUP

Please find below and/or attached an Office communication concerning this application or proceeding.



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04 JAN 12 AM 10:12

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SECRETARY		
ATTORNEY		

Exh. 1

# Notice of Abandonment

Application No.

09/574,688

Examiner

Mark W Bockelman

Applicant(s)

PICARDO ET AL.

Art Unit

3762

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

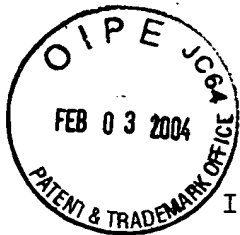
This application is abandoned in view of:

1. ☒ Applicant's failure to timely file a proper reply to the Office letter mailed on 26 June 2003.
  - (a) ☐ A reply was received on \_\_\_\_\_ (with a Certificate of Mailing or Transmission dated \_\_\_\_\_), which is after the expiration of the period for reply (including a total extension of time of \_\_\_\_\_ month(s)) which expired on \_\_\_\_\_.
  - (b) ☐ A proposed reply was received on \_\_\_\_\_, but it does not constitute a proper reply under 37 CFR 1.113 (a) to the final rejection.  
(A proper reply under 37 CFR 1.113 to a final rejection consists only of: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114).
  - (c) ☐ A reply was received on \_\_\_\_\_ but it does not constitute a proper reply, or a bona fide attempt at a proper reply, to the non-final rejection. See 37 CFR 1.85(a) and 1.111. (See explanation in box 7 below).
  - (d) ☒ No reply has been received.
2. ☐ Applicant's failure to timely pay the required issue fee and publication fee, if applicable, within the statutory period of three months from the mailing date of the Notice of Allowance (PTOL-85).
  - (a) ☐ The issue fee and publication fee, if applicable, was received on \_\_\_\_\_ (with a Certificate of Mailing or Transmission dated \_\_\_\_\_), which is after the expiration of the statutory period for payment of the issue fee (and publication fee) set in the Notice of Allowance (PTOL-85).
  - (b) ☐ The submitted fee of \$\_\_\_\_\_ is insufficient. A balance of \$\_\_\_\_\_ is due.  
The issue fee required by 37 CFR 1.18 is \$\_\_\_\_\_. The publication fee, if required by 37 CFR 1.18(d), is \$\_\_\_\_\_.
  - (c) ☐ The issue fee and publication fee, if applicable, has not been received.
3. ☐ Applicant's failure to timely file corrected drawings as required by, and within the three-month period set in, the Notice of Allowability (PTO-37).
  - (a) ☐ Proposed corrected drawings were received on \_\_\_\_\_ (with a Certificate of Mailing or Transmission dated \_\_\_\_\_), which is after the expiration of the period for reply.
  - (b) ☐ No corrected drawings have been received.
4. ☐ The letter of express abandonment which is signed by the attorney or agent of record, the assignee of the entire interest, or all of the applicants.
5. ☐ The letter of express abandonment which is signed by an attorney or agent (acting in a representative capacity under 37 CFR 1.34(a)) upon the filing of a continuing application.
6. ☐ The decision by the Board of Patent Appeals and Interference rendered on \_\_\_\_\_ and because the period for seeking court review of the decision has expired and there are no allowed claims.
7. ☐ The reason(s) below:

MARK W BOCKELMAN  
3762

Petitions to revive under 37 CFR 1.137(a) or (b), or requests to withdraw the holding of abandonment under 37 CFR 1.181, should be promptly filed to minimize any negative effects on patent term.

Exh. 1



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of

Atty. Docket

ANTHONY PICARDO

US 000423

Appln. No. 09/574,688

Group Art Unit 3762

Filed: May 17, 2000

Examiner Mark Bockleman

Title: SMART MEDICAL CONNECTOR SYSTEM AND METHOD OF USE

Assistant Commissioner of Patents and Trademarks  
Alexandria, VA 22313-1450

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[X] transmitted by facsimile to the U.S. Patent and Trademark Office at 703-872-9302

On:

July 15, 2003

By:

Elissa De Luccy

RESPONSE TO OFFICE ACTION

Sir:

In response to the Office Action dated June 26, 2003, Applicants respectfully point out that the current restriction requirement (group I (claims 1-7) and group II (claims 10-12) is inconsistent with the election requirement required in the Office Action dated March 13, 2003. In particular, the Office Action dated March 13, 2003, acknowledges that the scope of independent Claims 1, 10 and 17 are within Species I (a medical connector and method of use using an identifier that alters light received).

MPEP 806.04(e) states that species must be specifically different embodiments. Since the March 13, Office Action

states that no claim is generic, according to the Office Action; no single claim covers more than one embodiment.

However, the Office Action dated June 26, 2003 imposes a restriction requirement<sup>1</sup> within a single species. It is not seen how claims within the scope of one specific species can define independent and distinct inventions.

In addition, MPEP 811 states that before making a restriction requirement after a first office action on the merits, the examiner should consider whether there would be a serious burden if restriction were not required. In the present case, it is highly likely that a single search may locate prior art, if any, relevant to both Groups I and II. It is also noted that the combination (claims 10-12) substantially includes all the features of the subcombination (claims 1-7). Accordingly, it is respectfully submit that there would be no serious burden if the restriction were not required.


In any event, Applicants' request clarification regarding the election/restriction requirements so that an appropriate election/restriction can be made.

---

<sup>1</sup> It is also noted that Claims 17-32 were not addressed in the Office Action dated June 26, 2003.

Applicants' undersigned attorney may be reached by  
telephone at the number given below.

Respectfully submitted,

  
By \_\_\_\_\_  
Tony E. Piotrowski,  
Reg. 42,080  
(914) 333-9609

\*\*\*\*\*  
\*\*\* TX REPORT \*\*\*  
\*\*\*\*\*

TRANSMISSION OK

TX/RX NO  
CONNECTION TEL  
CONNECTION ID  
ST. TIME  
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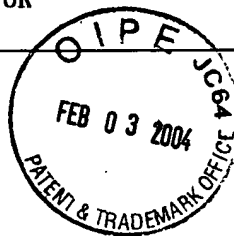
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of

Atty. Docket

ANTHONY PICARDO

US 000423

Appln. No. 09/574,688

Group Art Unit 3762

Filed: May 17, 2000

Examiner Mark Bockleman

Title: SMART MEDICAL CONNECTOR SYSTEM AND METHOD OF USE

Assistant Commissioner of Patents and Trademarks  
Alexandria, VA 22313-1450

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Office at 703-872-9302

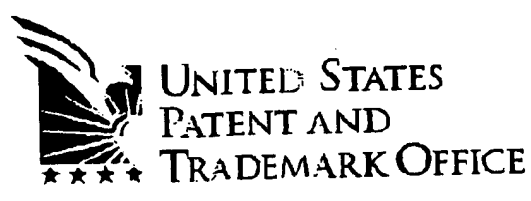
On: July 15, 2003By: Chas De LuccyRESPONSE TO OFFICE ACTION

Sir:

In response to the Office Action dated June 26, 2003,  
Applicants respectfully point out that the current restriction  
requirement (group I (claims 1-7) and group II (claims 10-12)  
is inconsistent with the election requirement required in the  
Office Action dated March 13, 2003. In particular, the Office



# Auto-Reply Facsimile Transmission



TO: Fax Sender at 914 332 0615  
Fax Information  
Date Received: 7/15/03 3:07:09 PM [Eastern Daylight Time]  
Total Pages: 3 (including cover page)

**ADVISORY:** This is an automatically generated return receipt confirmation of the facsimile transmission received by the Office. Please check to make sure that the number of pages listed as received in Total Pages above matches what was intended to be sent. Applicants are advised to retain this receipt in the unlikely event that proof of this facsimile transmission is necessary. Applicants are also advised to use the certificate of facsimile transmission procedures set forth in 37 CFR 1.8(a) and (b), 37 CFR 1.6(f). Trademark Applicants, also see the Trademark Manual of Examining Procedure (TMEP) section 306 et seq.

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Cover  
Page  
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07/15/03 TUE 15:07 FAX 914 332 0615 PHILIPS ELECTRONICS 0001

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of Atty. Docket  
ANTHONY PICARDO US 030423  
Appln. No. 09/574,688 Group Art Unit 3762  
Filed: May 17, 2000 Examiner Mark Bockleman  
Title: SMART MEDICAL CONNECTOR SYSTEM AND METHOD OF USE  
Assistant Commissioner of Patents and Trademarks  
Alexandria, VA 22313-1450

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On: July 15, 2003  
By: [Signature]

RESPONSE TO OFFICE ACTION

Sir:

In response to the Office Action dated June 26, 2003, Applicants respectfully point out that the current restriction requirement (group I (claims 1-7) and group II (claims 10-12) is inconsistent with the election requirement required in the Office Action dated March 13, 2003. In particular, the Office Action dated March 13, 2003, acknowledges that the scope of independent Claims 1, 10 and 17 are within Species I (a medical connector and method of use using an identifier that alters light received).

MP2P 806.04(a) states that species must be specifically different embodiments. Since the March 13, Office Action

1

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Exh. 3



9200/3762  
D.A.C.

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PTO/SB/21 (08-00)  
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<b>TRANSMITTAL FORM</b> <i>(to be used for all correspondence after initial filing)</i>	<b>Application Number</b>	09/574,688	
	<b>Filing Date</b>	May 17, 2000	
	<b>First Named Inventor</b>	Anthony G. Picardo	
	<b>Group Art Unit</b>	3762	
	<b>Examiner Name</b>	M. Bockelman	
<b>Total Number of Pages in This Submission</b>	11	<b>Attorney Docket Number</b>	US000423

ENCLOSURES (check all that apply)		
<input type="checkbox"/> Fee Transmittal Form <input type="checkbox"/> Fee Attached <input type="checkbox"/> Amendment / Reply <input type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declaration(s) <input type="checkbox"/> Extension of Time Request <input type="checkbox"/> Express Abandonment Request <input type="checkbox"/> Information Disclosure Statement <input type="checkbox"/> Certified Copy of Priority Document(s) <input type="checkbox"/> Response to Missing Parts/Incomplete Application <input type="checkbox"/> Response to Missing Parts under 37 CFR 1.52 or 1.53	<input type="checkbox"/> Assignment Papers (for an Application) <input type="checkbox"/> Drawing(s) <input type="checkbox"/> Licensing-related Papers <input checked="" type="checkbox"/> Petition <input type="checkbox"/> Petition to Convert to a Provisional Application <input type="checkbox"/> Power of Attorney, Revocation Change of Correspondence Address <input type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Request for Refund <input type="checkbox"/> CD, Number of CD(s) _____	<input type="checkbox"/> After Allowance Communication to Group <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input type="checkbox"/> Appeal Communication to Group (Appeal Notice, Brief, Reply Brief) <input type="checkbox"/> Proprietary Information <input type="checkbox"/> Status Letter <input checked="" type="checkbox"/> Other Enclosure(s) (please identify below):  Receipt Confirmation Postcard
<b>Remarks</b>		<b>RECEIVED</b>  FEB 09 2004  TECHNOLOGY CENTER R3700

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT	
Firm or Individual name	W. Brinton Yorks, Jr. Reg. #28,923
Signature	<i>W. Brinton Yorks, Jr.</i>
Date	1/30/04

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Typed or printed name	Jill Peistrup
Signature	<i>Jill Peistrup</i>
Date	30 January 2004

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